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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/685,274

10/09/2000

Eric Sean Parham

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BAKER BOTTS L.L.P.

2001 ROSS AVENUE

SUITE 600

DALLAS, TX 75201-2980

EXAMINER

LEVITAN, DMITRY

ART UNIT

PAPER NUMBER

2416

NOTIFICATION DATE

DELIVERY MODE

02/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<i>Office Action Summary</i>	Application No.	Applicant(s)	
	09/685,274	PARHAM ET AL.	
	Examiner	Art Unit	
	Dmitry Levitan	2416	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Amendment, filed 11/26/07, has been entered. Claims 1-26 remain pending.

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126, as amended claims comprise two claims sharing the same number 24

Misnumbered last/second claim 24 has been renumbered as claim 26.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11 and 16 of U.S. Patent No. 6,839,342.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed method, particularly claim 5, and the methods of the patent are directed to the same gateway for interfacing Class 5 switch and IP network.

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Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 21 limitations, comprising a computer readable medium including code for interfacing between signaling protocols, are directed to non-statutory matter. See Interim Guidelines for examination of patent applications for patent subject matter eligibility, pages 50-54.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected as a single means claim.

2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5, 16 and 25 limitations, directed to elimination of coupling of the Class 5 switch to the Internet protocol network, are unclear, because meaning of "coupling" is not understood in the context of the claims, as coupling of two devices is not limited to their direct connection, but devices can be coupled through any intermediate device or devices.

9. Claims 2-4, 6-13 and 17 are rejected as the claims depending on the claim rejected above.

Claim Rejections - 35 USC § 103

10. Claims 1-5, 7-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Technical report on DSL forum TR-036, version 1.0, August 28, 2000, pages 1-41 in view of Kaczmarczyk (US 6,775,269).

11. Regarding claims 1- 4, 9-11, 14, 15, 21, 22 and 24, Technical report substantially teaches the limitations of claims:

a system a method and a computer program for interfacing between signaling protocols (shown as network Interworking Function CO-IWF on Fig. A-1 and disclosed on A.1.1.2), comprising a device operable to receive signaling information in one format and operable to convert the format to a broadcast loop emulation service/BLES signaling protocol (converting signaling and bearer services/voice channels between PSTN Class 5 and BLES formats, as disclosed on A.1.1.1 and A.1.3), the device operable to provide dial tone generation, hook flash detection, caller identification generation, digit collection, call progress tones and tone detection

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capabilities (disclosed as generic services that are supported in Class 5 switching equipment, inherently identifying all generation, detection, collection and call progress operations, because these operations are essential for Class 5 switch function and are described in appropriate Telcordia or ETSI standards, as disclosed on A1.4 and A.1.4.1), wherein the device determines which of the capabilities to perform from the signaling information (performing translation of corresponding signaling techniques to transparently extend the signaling into other type of network, as described on A.1.4).

Technical report does not teach implementing the device as a gateway, using media gateway and call session control format and implementing Class 5 switch as softswitch.

Kaczmarczyk teaches implementing the device as a gateway, shown as a combination of signaling gateway INIP 16 and Media gateway 18 on Fig. 1 and disclosed on 4:60-5:64, and using media gateway and call session control format, disclosed as SIP protocol to perform SS7 messaging in IP environment/Internet, as disclosed on 1:37-2:25.

Official notice is taken that using a softswitch is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add implementing the device as a gateway and implementing Class 5 switch, as softswitch, using media gateway and call session control format of Kaczmarczyk to the system of Technical report to improve the system interworking between PSTN and IP environment by using media gateway and call session control format for SS7 messages in IP network, utilizing well-known advantages of softswitch implementation of Class 5 switch.

12. Regarding claims 5, 8, 16 and 25 (as best understood), Technical report teaches CO-IFW receiving voice and signaling information generated by Class 5 switch, as the switch receives the

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voice and signaling information from PSTN, as shown on Fig. A-1, and converting the voice and signaling information into IP data packets for IP-based BLES, as described on A.13, wherein Class 5 switch is coupled only to CO-IFW without a direct connection with Broadband Network, as shown on Fig. A-1.

13. Regarding claims 7, 17 and 26, Kaczmarczyk teaches using two separate logical links for transferring signaling, SIP 22, and data/voice packets, IP 26, to IP network as shown on Fig. 1 and disclosed on 5:50-65.

14. Regarding claims 12, 13, 19, 20 and 23, Technical report teaches channel associated signaling format and common channel signaling, as disclosed on A1.3.2.

15. Regarding claim 18, Technical report teaches providing BLES protocol to an integrated access device at a customer premises, shown as Network Termination/B-NT device on Fig. A-1 and disclosed on A.1.1.4 and A.1.1.5, which is alternatively located at customer premises, as disclosed on 5.1.5-5.1.8?

16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Technical report in view of Kaczmarczyk.

Technical reporting view of Kaczmarczyk substantially teaches the limitations of the claim (see parent claims rejection above), including use of separate IP logical links, as described in claims 7, 17 and 26 rejection above.

Technical reporting view of Kaczmarczyk does not teach using a single physical connection to IP network.

Official notice is taken that combining two logical links in a single physical connection is well known and expected in the art.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine two logical links of Kaczmarczyk into a single physical connection/interface in the system of Technical report Kaczmarczyk to simplify the system design by utilizing a single interface between the combination of gateways 16 and 18 and IP network 14, to reduce the system cost.

Response to Arguments

17. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Levitan whose telephone number is (571) 272-3093. The examiner can normally be reached on 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dmitry Levitan
Primary Examiner
Art Unit 2416

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Primary Examiner, Art Unit 2416